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REMARKS

Applicant acknowledges that claims 1-23 are pending in the application, and that the Office currently holds claims 1-23 as rejected. Applicant thanks the Examiner for his careful review of the specification, and the correction made to the IDS of a typographical error.

Applicant herein amends claim 1 to more clearly indicate that which he considers to be his invention. Applicant amends claim 1 to include the limitations of original claims 2-4, 15 and 16. Therefore, the amendment of claim 1 is supported by the specification as originally filed and adds no new matter to the application. Further, Applicant herein requests cancellation of claims 2-4, 15 and 16 without prejudice. Other claims are amended to properly correct their dependency in view of the amendment to claim 1 and the aforementioned cancellation claims.

35 USC §112, 2d paragraph

The Office holds claims 5 and 6 rejected under 35 USC §102(e) as being indefinite. The Office contends that in claims 5 and 6, it is uncertain whether "the global communications network" refers to "a global network" or "a global digital communications network" of claim 1.

Applicant does not concur with the uncertainty expressed by the Office. In response, Applicant submits the term "a global network" is a portion of the descriptive part of the nominative phrase "a global network interactive recipient profile input form" describing the object of the phrase: "form." Whereas the nominative phrase "the global communications network" clearly has the noun "network" as its object. Applicant submits that insofar as neither nominative phrase has the same noun as its object, they are clearly understandable as being different objects. However, in the interest of expediting prosecution, Applicant herein amends claims 5 and 6 to recite the further descriptive adjective "digital" in conjunction with the nominative phrase "the global communications network."

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35 USC §102(e)

The Office holds claims 2-23 rejected under 35 USC §102(e) as being anticipated by Kamakura *et al.* (US Patent No. 6,047,310, the '310 patent) in view of Capps (US Patent No. 6,711,682. Applicant respectfully traverses these rejections.

In response, Applicant asserts that the electronic message management system of the present invention is not the same as the apparatus of the Kamakura '310 patent. The apparatus of Kamakura provides for "distributing non-specific information from a sender to a receiver..." Col. 1, lines 52-53. What this means is that the Kamakura apparatus does not receive messages addressed to a specific receiver. The Kamakura apparatus is designed and functions as a message "matching filter" apparatus. It receives a message from a single sender and sends the message out to a plurality of receivers (who were non-specified by the sender) based on a match between a receiver's profile and the message's profile.

In contrast, in the present invention functions as a message "sorting filter" system. It receives a message sent to a specific (as opposed to a non-specific) receiver, and selects which of that individual receiver's "mail boxes" to sort the message into. The present system cannot relay a received message on to a plurality of non-specific receivers.

Applicant submits that the standard for finding anticipation is one of strict identity. In other words, to anticipate under §102, a single prior art reference must disclose all the elements, or disclose their equivalents functioning in the same way as the claimed invention (*Shanklin Corp. v. Springfield Photo Mount Co.*, 187 USPQ 129, 133). Further, "too many structural and operational differences" negate anticipation within the meaning of §102 (*ibid.*, 134). Neither the Kamakura apparatus nor the present invention can do what the other does. Nor is the Kamakura '310 patent enabling of the present invention. Because the Kamakura apparatus will not do what the present invention does, it does not *prima facie* anticipate the present electronic message management system of claim 1.

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35 USC §103(e)

The Office holds claims 2-23 rejected under 35 USC §103(e) as being unpatentable over Kamakura *et al.* (US Patent No. 6,047,310, the '310 patent) in view of Capps (US Patent No. 6,711,682, the 682 patent). Applicant respectfully traverses these rejections.

Regarding Original Claim 2:

Applicant herein cancels original claim 2. Therefore, the rejections of original claim 2 and the claims dependent thereon are moot. However, Applicant herein amends original claim 1 to include the limitations of original claim 2 and others. Therefore, Applicant addresses the rejection of claim 2 and its dependents below regarding amended claim 1.

Regarding Amended Independent Claim 1:

Applicant submits that regarding currently amended claim 1, the Office has failed to establish a *prima facie* case of obviousness. Applicant asserts that Kamakura *et al.*, neither by itself nor in combination with the Capps '682 patent, does not render the invention of instant independent claim 1 obvious for the reasons set forth below.

Prima Facie Obviousness

The PTO has the burden under 35 USC §103 of establishing a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). To establish a *prima facie* case of obviousness, three basic criteria must be met (MPEP §706.02(j)):

- (1). There must be some suggestion or motivation in the reference itself to modify the reference or combine the teachings of the references to seek the invention of the instant claims; and
- (2). There must be a reasonable expectation of successfully accomplishing the invention of the instant claims; and

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- (3). The prior art reference (or references when combined) must teach or suggest all the instant claim limitations.

Additionally, both the teaching (or suggestion) and the expectation of success must be found in the cited prior art, and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Criterion 1; Suggestion or Motivation:

"THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION" (MPEP §2143.01, emphasis in original). Obviousness can only be established by a combination of prior art references where the teaching, or suggestion or motivation to make the combination is found in the references themselves.

Applicant submits that there is no suggestion or teaching in either of the cited references to provide electronic message management system having the features of a message "sorting filter" system, where a received message was sent to a specific (as opposed to a non-specific) receiver, and the system selects which of that individual receiver's "mail boxes" (receiving modalities) to sort the message into. Therefore, the combination of the cited references fail to meet Criterion 1 to establish a *prima facie* case of anticipation, the present rejection of claims is not proper under the MPEP.

Criterion 2; Reasonable Expectation of Success:

As noted above under §102, either the Kamakura apparatus nor the present invention can do what the other does. More particularly, the Kamakura '310 patent is not enabling of the present invention, Kamakura neither alone or in combination with Capps enables the receiver to designate "where, when and how" specific types of messages from a sender/messenger are to be sorted for delivery to the receiver/recipient. For example, in the present invention the recipient can designate in advance that car advertisements from one sender/messenger go to email address-1 anytime one arrives at the present message management system, that statements from the bank go to email address-2 on the

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15th of the month, that the bill from the utility company goes to email address-3 on the first of the month and is copies to email address-2, etc. The teachings of Kamakura, neither alone or in combination with Capps, has any expectation of accomplishing this object of the present invention. Because the Kamakura/Capps do not enable the present invention, they do not *prima facie* anticipate the present electronic message management. Therefore, Criterion 2 is not met and the present rejection of claims is not proper under the MPEP examining practice.

Criterion 3; Must Teach or Suggest All the Claim Limitations:

Inter alia, the message management system of instant claim 1 recites the limitation of "delivery parameters" on the profile data. Further, instant claim 1 recites the additional limitation on the delivery parameters including data on "where, when and how specific types of messages from a messenger are delivered to a recipient." These limitations are not taught or suggested in either the Kamakura or the Capps references.

Another limitation of instant claim 1 is an "individual message generator. . . to generate an individual message to be sent. . . to a recipient *specified* by a messenger." Emphasis added. To the contrary, in a combination of Kamakura and Capps (even if successfully combined) the sender transmits its message to the apparatus; it is the apparatus that designates the receiver of the message.

Therefore, the cited references, neither alone nor in combination teach or suggest all the limitations of instant claim 1, and criterion 3 is not met and the present rejection of claims again is not proper under the MPEP.

Regarding Claims : Rejection Moot


In view the above amendment and remarks regarding independent claim 1, Applicant submits that the current rejection of dependent claims 5-10, 17-23 and claims 11-14 under §103(e) is now moot.

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Applicant believes that the above amendments and remarks are fully responsive to the Office Action mailed 10 February 2005. Applicant respectfully requests reconsideration and removal of all objections and rejections of claims, and that, in view of the above amendments and remarks, the application is now in condition for allowance. Applicant respectfully requests the Examiner to contact the undersigned to timely resolve any minor issues that may remain in the application. Alternatively, Applicant invites the Examiner to suggest alternative claim language for Applicant's consideration, in order to facilitate timely prosecution of this application.

Respectfully submitted,

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Date


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